

REMARKS

Specification

The Examiner has objected to the amendment filed to the specification as being new matter under 35 U.S.C. 132. Applicant's amendment to include reference numeral 33A is not new matter and is clearly supported by the original specification. Applicant respectfully directs the Examiner's attention to Fig. 2, element 32. The crosshatching within the rectangle of slit 32 clearly shows plastic disposed therebehind. Moreover, the originally filed specification explicitly recites the provision of plastic material inside wipe containing compartment 24. See paragraph at page 7, line 13 - page 8, line 3. Merely adding a reference number does not constitute new matter. Amendments that merely clarify or make definite that which an originally-filed application expressly or inherently disclosed or conform the specification to the originally disclosed drawings or claims, do not violate the rule on new matter (See generally, *Triax Co. v. Hartman Metal Fabricators, Inc.*, 479 F.2d 951, 956-957, 178 USPQ 142, 146 (2d Cir. 1973), *cert. denied*, 414 U.S. 1113 (1973); *In re Wright*, 343 F.2d 761, 767, 145 USPQ 182, 188 (CCPA 1965), discussed at N. 6 *infra*). Similarly, when the formal drawings which clarify the plastic crosshatching are accepted, this objection becomes moot.

Claim Rejections - 35 USC 112

The Examiner has rejected claims 1-3 and 5-18 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The Examiner asserts that the claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. The Examiner insists that the original disclosure does not teach the selectively incremental or full access to the compartments. ✓

Applicant respectfully traverses the rejection and submits that the added matter is inherent in the application as filed. One skilled in the relevant art surely recognizes that one of the many advantages of strip-type Velcro, zippers and similar type lengthwise fasteners (in contrast to a point fastener, like a button) is its versatility, where it can be either completely

fastened, partially fastened, or unfastened completely. In this case, the length of Velcro material is being used for sealing the lengths of the side edges of the panels, and as the originally filed application points out, one of the advantages of the bag is to allow the user of the bag to open the bag with only one hand, by pulling against one handle or panel while the other panel is held on the shoulder. Velcro material, extending along the length of the panels, facilitates the incremental opening of the bag because the user can exert the desired amount of downward force in relation to how much access to the bag they prefer at any given time. Thus, the bag selectively provides incremental or full access to the compartments depending on the amount of force the user exerts while the bag is being opened, all the time while the bag is worn over the shoulder.

Matter added that makes explicit that which was implicit, inherent or intrinsic in the original disclosure is not new matter and is permitted. A property, or advantage, shown in the original disclosure (the Velcro material along the length of the panels is clearly described and shown in the application as filed) per se, is not a different invention. It is, in fact, inherent in the invention that is already disclosed and properly supported under 35 USC 112. See generally, *In re Davies*, 475 F.2d 667, 177 USPQ 381 (CCPA 1973), and *Rhone-Poulenc v. Dann, Comm'r Pats.*, 507 F.2d 261, 184 USPQ 196 (4th Cir. 1974). The amendment to the claims is fully supported by the specification (the written description and drawings, as filed) because this feature is implicit in the use of a strip or length of Velcro material extending along the corresponding lengths of the mating panels. The fastener strips can be used to selectively provide the desired amount of access to the compartment, all while the bag is worn over the shoulder of the caregiver of the infant.

Drawings

The Examiner has disapproved the proposed drawing correction and substitute sheets of drawings as allegedly introducing new matter. Specifically, the Examiner now cites seven areas in which new matter was allegedly introduced. None of the seven areas cited are of any significant relevance to the claimed invention. The first and third areas of objection (a and c) merely refer to the relative sizes of several of the elements of the invention. Nowhere in 37 CFR or MPEP § 608.02 is there a requirement that formal drawings must be to the same scale as the

informal drawings; that is, various elements may be larger or smaller than they actually are in relation to each other. Moreover, it is very clear to one of ordinary skill in the art that the drawings as originally filed were informal and certainly not to scale. No aspect of the objected to portions of the drawings are found in the claims and therefore there is no new matter. The drawings differ in insignificant and immaterial ways from the original drawings but certainly one of ordinary skill in the art, when reading the original disclosure and drawings, has a full appreciation of the claimed invention. No new matter, i.e., information needed to support the claims, has been added. It is respectfully yet forcefully requested that the Examiner confer with his supervisor on this issue. It is most frustrating to continue to deal with issues that are relatively clear to most Examiners. Applicant's attorney is not trying to be mean-spirited or disrespectful but it is basic patent law that not every addition to an application and/or claim is new matter. The important question on the determination of the issue is whether the claim is supported by the original disclosure. Thus, in this case, there is no new matter, as that term is understood in the patent law context.

The second area of objection is that fold-over flaps 36 and 38 are shown as "attached to panel 30, and this is not shown in the original drawings." Applicant respectfully submits that flaps 36 and 38 are shown in the original drawings in schematic form and are thus not limited to being attached exclusively to either pocket 18, 20 or panel 30, since the drawings were informal. Moreover, owing to the extremely slight overlap of flaps 36 and 38 in the respective upper right corners of pockets 18 and 20, Applicant contends that the original drawings do in fact support a reading or understanding, to those of skill in the art, that the fold over flaps are attached to panel 30. To one of ordinary skill, the drawings, originally informal, correctly correspond and are copied by the formal drawings. Again, no new matter has been introduced, i.e., matter needed to support the claims.

The fourth objection is that "there is only one hinge line 41 in the original drawing." Applicant respectfully submits that element 41 is a hinged edge made of a plastic material as described in the specification (see, e.g., page 5, lines 11-14). As such, and because nothing in the universe is foldable to a perfect one-dimensional line, hinged edge 41 necessarily has some thickness and some curvature to it, as one of ordinary skill in the art would understand from the

description of the device as a diaper bag. The single “hinge line 41” shown in the original drawings is a schematic approximation of such a hinge; the two lines shown in the formal drawings are a more accurate representation of what the hinge would look like. No new matter has been introduced. There is nothing in the new drawings that one of ordinary skill in the art would not appreciate when first viewing the informal drawings, as understood in connection with the original detailed written description.

The fifth alleged addition is that “handles 16 are attached to the outside of the bag in the original drawings.” This statement is not entirely accurate. The handles are shown as attached to the outside of the bag in original Figs. 1 and 2 but to the inside of the bag in original Fig. 3. Moreover, Claim 1 as originally written and submitted recites “an over the shoulder-size handle secured to a first of said panels....” Similar language is present in originally-filed Claim 16. The claims of the application are certainly a part of the application upon which antecedent basis may be based. By the use of the simple wording “to” instead of “to an inner/outer side of,” Applicant taught that one could secure the handles to either the inside or the outside (or even directly to the edge) of the panels. Incidentally, since precise location/placement of the handles (inside, outside or edge bound) are not a feature of the claimed invention, the specification, or in relation to the prior art, it is unclear why it matters at all where the handles are physically attached to the panels. The claims require that the handles are attached to the panels. No new matter has been introduced, since the original drawings and written description are understood by those of skill in the art to cover either embodiment.

The sixth and seventh alleged additions focus on the attachment below portion 45 and 43 in the drawings. Applicant respectfully submits that the attachment as shown in the original drawings is in schematic form and is thus not limited to being attached exclusively below or above (inherently creating a seam), or on top of portion 45 and 43, since the drawings were informal. To one of ordinary skill, the drawings, now formal correctly correspond to the originally informal drawings. Again, no new matter has been introduced. The Examiner’s position is not supported by the understanding of the term “new matter” in the context of patent law. It is not anything introduced into a drawing or specification, only that which is needed to support the claim. As such, there is no new matter and the Examiner’s objection should be

withdrawn.

Applicant refers the Examiner to 37 CFR § 1.81, which describes the purpose of drawings in a utility application:

- (a) The applicant for a patent is required to furnish a drawing of his or her invention where necessary for the understanding of the subject matter sought to be patented; this drawing, or a high quality copy thereof, must be filed with the application. [...]
- (b) Drawings may include illustrations which facilitate an understanding of the invention (for example, flow sheets in cases of processes, and diagrammatic views).

The remaining requirements under §§ 1.83-84 pertain to matters such as line quality and margins, all of which conditions the submitted formal drawings satisfy. Applicant respectfully submits that the submitted formal drawings fulfill the statutory purpose of patent drawings and do not add new matter to the application. An example of new matter would be the addition of an umbrella to the bag and a claim to a combination of a bag and umbrella. As has been long the law, “[i]n a sense, anything inserted in a specification that was not there before is new to the specification but that does not necessarily mean it is prohibited as ‘new matter.’” *In re Oda*, 170 USPQ 268, 270 (CCPA 1971). Insertions by way of amendment in the drawing of a patent application do not invalidate the patent, if they are reasonably indicated to be within the invention. *Michigan Carto Co. v. Sutherland Paper Co.*, 29 F.2d 179, 184 (6th Cir. 1928). Slightly changing the size of one element with respect to another is not new matter for utility patent application drawings, particularly when the originally submitted drawings are informal. The claims do not recite the relative sizes of these elements, and the original drawings are understood by one of skill in the art to encompass various sizes and size relationships of the elements. Accordingly, it is respectfully submitted that the formal drawings submitted do not add new matter and should be accepted.

The Examiner has renewed the objection concerning the “lined plastic” (i.e., plastic liner material) of Claim 11. This objection is respectfully traversed. In Fig.2, slit 32 clearly shows plastic disposed therebehind (the crosshatching within the rectangle of slit 32). When the formal drawings are accepted, this objection will be moot.

Claim Rejections - 35 USC 103

The Examiner has again rejected all of the claims of the instant application. Specifically, Claims 1, 2, 4-11, and 13-18 were rejected under 35 USC § 103(a) as anticipated by Medow (4683570) in view of Manning (3143748). The remaining claims were rejected as obvious under §103(a) in view of a variety of prior patents. Applicant respectfully traverses these rejections and has amended the independent claims (in the prior filing) to place the application in better form for further examination and, it is believed, in condition for allowance.

Foremost, the cited prior art fails to teach or suggest the Applicant's invention. Medow shows an activity tote having two hinged halves which meet together to form an enclosure. There is neither a teaching nor a suggestion of utilizing Velcro material along the lateral edges for completely enclosing the sides of the pocketbook and to allow for incremental opening of the same while maintaining the bag over the shoulder of the caregiver. Applicant's invention contemplates two panels which are hingedly connected together with the side edges of the panels being provided with Velcro material for sealing the edges thereof. Then, with at least one oversized handle for allowing the bag to be placed over a shoulder, the same hand of the shoulder can be used to open the bag. This is not taught nor suggested by the Medow reference. The use of Velcro material along substantially the length of the side panels allows the bag to be incrementally opened, i.e., a little bit, half way, all the way, or any degree in between as desired by the user. By contrast, Medow shows the use of points of Velcro material and only at the top edges and thus the bag is either fully closed or open. Patentable subject matter exists in this aspect of the claimed invention.

The Manning reference does not make up for the deficiencies in Medow. Specifically, Manning teaches a mat that is collapsible into a bag-like structure in which articles can be held and carried. The Manning container lacks the ability to be opened and closed with only one hand; moreover, Manning lacks compartments to effectively store items separately from each other. Again, Manning functions primarily as a seat cushion or a mat. There must be a reason or suggestion in the art for combining the references, other than the knowledge obtained from Applicants' disclosure. *In re Dow Chemical*, 5 USPQ2d 1529, 1532 (Fed. Cir. 1988) (citing *Interconnect Planning Corporation v. Feil*, 227 USPQ 543, 551 (Fed. Cir. 1985)), *ACS Hospital*

Systems v. Montefiore Hospital, 221 USPQ 929, 932 (Fed. Cir. 1984). The mere fact that the prior art could be so modified does not make the modification obvious unless the prior art itself suggests the desirability of the modification. *In re Gordon*, 221 USPQ 1125 (Fed. Cir. 1984). The Federal Circuit has, on numerous occasions made this point clear. For example, the court stated in *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 221 USPQ 929 (Fed. Cir. 1984) that:

obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under § 103, teachings of references can be combined only if there is some suggestion or incentive to do so.

ACS Hospital Systems, at 932-933.

Here, the Examiner has failed to show how one would be motivated to combine the teachings of the Manning patent (lengthwise Velcro material) to the Medow patent (already provided with Velcro material, at points, along the top edge) other than by reading Applicant's application. The Examiner has failed to meet his burden of establishing a *prima facie* case for obviousness. Even with the proposed combination, there is no teaching of Velcro fastening along the entire edges of the panels to allow for incremental opening or closing of the device while wearing the device over one's shoulder. It is true that Manning shows Velcro material running along the sides of the interior of the seat cushion or mat, however there is no reason why anyone would need incremental access to the interior of the Manning device while the device is worn over one's shoulder, since it is primarily a cushion and in no way wearable as a pocketbook. Even the straps of the Manning reference teach away from the present invention and away from any combination of the two pieces of prior art. The straps of Manning show that the device is not intended to be opened when (assuming, which is not shown, that the strap is large enough to be worn over the shoulder) worn over the shoulder. The extension of the strap in Manning from one panel to the other panel precludes opening of the device while the strap is on the shoulder. The rationale to modify or combine the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the

teaching of the references. *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). The Examiner has not presented such a convincing line of reasoning. Without the benefit of Applicant's claims as a guide, an artisan would have no motivation to combine the teachings of Meadow '570 and Manning '748.

The remaining prior art is equally deficient in teaching or suggesting a diaper bag that can be worn over a shoulder and simultaneously opened with but a single hand. Not one of the references teaches or suggests enabling the user to incrementally open (and still have the lower portion of the bag closed by the non-opened Velcro opening) the bag with one hand by pulling down on a panel while still wearing the bag over a shoulder to access the pockets disposed on the interior of the bag.

Applicant has hereinabove amended the claims to point out the distinctions between the invention and the cited art, either when the art is individually considered or even if combined together as suggested by the Examiner. In the absence of an uncovering of more pertinent prior art, this application is in a condition of allowance. The prior art, either individually considered or even if combined as suggested, neither teaches nor suggests the claimed invention. Prompt and favorable allowance is solicited and believed fully warranted.

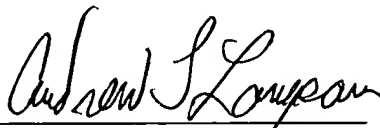
In view of the foregoing, Claims 1-3 and 5-18 are believed to recite patentable subject matter, and this application is believed to be in a condition of allowance. The prior art of record neither teaches nor suggests the invention, either when the various references are taken alone or in combination. **The Examiner is invited to telephone the undersigned to discuss any further changes that might be deemed necessary.** Prompt and favorable action toward the issuance of a patent is earnestly solicited and believed to be fully warranted.

Applicant hereby petitions for any extension of time which may be required to maintain the pendency of this case, and any additional required fee, except for the Issue Fee, for such extension is to be charged to Deposit Account No. **02-2105**.

Respectfully submitted,

Dated: October 27, 2003

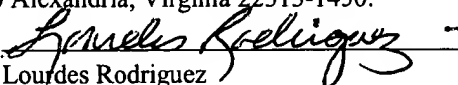
LEVISOHN, BERGER & LANGSAM, LLP
805 Third Avenue
19th Floor
New York, New York 10022
(212) 486-7272



Andrew S. Langsam
Reg. No. 28,556
Attorney for Applicant

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Lourdes Rodriguez
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